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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,653	06/29/2001	Alan Chris Berkema	10016783-1	9773

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/897,653	Applicant(s) BERKEMA ET AL.	
	Examiner Jerome Grant II	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 6, 15, 17, 18, 21-24, 30, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 6, 15, 17, 18, 21-24, 30, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



Detailed Action

1. Claims 2-4, 6, 15, 17, 18, 21-24, 30, 32 and 33 were on appeal based upon finally rejected claims.

The rejection of June 30, 2005 is withdrawn based upon the arguments presented in the brief. However new art has been found which is relevant and applicable to the claims at issue.

2.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2, 3, 6, 30, 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

With respect to claim 2, there is no support in the specification for “the reference specifies billing..” At best, the top of page 13 of the specification states that the user manipulates the billing information.

Art Unit: 2626

With respect to claim 3, there is no support for the reference specifies print format information. The format information appears to be done by the print service 16, according to page 10, lines 5-9 of the specification.

With respect to claim 6, there is no written support for the references including a number of copies of the print content.

With respect to claim 30, there is no statement in the specification that the print format data that is to be printed is specified on a new sheet of paper.

With respect to claims 32 and 33, there is no support for Bluetooth communication protocol

3.

Claims 2, 3, 6, 30, 32 and 33 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the lack of support as provided in the above numbered paragraph.

4.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-4, 6, 15, 17, 18, 21-24 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Kemp.

With respect to claim 2, Kemp teaches a print reference method executable by a portable wireless device (20, 100) the method comprising the steps of:

Obtaining a reference (www server DS) to print content stored at a location indicated by the reference; and wirelessly communicating (see figures 1 and 2) the reference to another device to initiate a print by reference of the print content, wherein the reference specifies billing information, see paragraphs 111 and 112.

With respect to claim 3, Kemp teaches a print reference method executable by a portable wireless device, the method comprising the steps of:

Obtaining a reference (www server DS) to print content stored at a location indicated by the reference; and wirelessly communicating (see figures 1 and 2) the reference to another device to initiate a print by references of the print content, wherein the references specifies print format information, see para. 122 lines 1-10, the WWW server DS is converted by data format conversion terminal CS.

With respect to claim 4, Kemp teaches a print reference method executable by a portable wireless device, the method comprising the steps of:

Obtaining a reference (www server DS) to print content stored at a location indicated by the reference; and wirelessly communicating (see figures 1 and 2) the reference to another device to initiate a print by references of the print content, wherein the reference specifies the time and date information. This limitation is substantially taught at paragraph 75 where the time is inherent with respect to signals detected by the satellites.

With respect to claim 6, Kemp teaches a print reference method executable by a portable wireless device, the method comprising the steps of:

Obtaining a reference (www server DS) to print content stored at a location indicated by the reference; and wirelessly communicating (see figures 1 and 2) the reference to another device to initiate a print by references of the print content, wherein the references specifies the number of copies of the print content to be printed by the print device, see paragraph 143.

With respect to claim 15, Kemp teaches a print reference method executable by a portable wireless device, the method comprising the steps of:

Obtaining a reference (www server DS) to print content stored at a location indicated by the reference; and wirelessly communicating (see figures 1 and 2) the reference to another device to initiate a print by references of the print content; and communicating a discovery signals (print ID request) that comprises a request for information about the capability of the another device. The request of capability is whether the another printer can be selected (see paragraphs 136 and 137) or if the another device can print color (see paragraph 134).

With respect to claim 17, Kemp teaches a print reference method executable by a portable wireless device, the method comprising the steps of:

Obtaining a reference (www server DS) to print content stored at a location indicated by the reference; and wirelessly communicating (see figures 1 and 2) the reference to another device to initiate a print by references of the print content; and receiving a print status message from the another device, see paragraphs 121 and 123 of Kemp.

With respect to claim 18, Kemp teaches the status is the actual printing of a job after the authentication process has been satisfactory and the job has been reviewed by the user, subsequently, the billing process is confirmed and the print data may be obtained. See para. 124.

With respect to claim 21, Kemp teaches a print reference method executable by a portable wireless device, the method comprising the steps of:

Obtaining a reference (www server DS) to print content stored at a location indicated by the reference; and wirelessly communicating (see figures 1 and 2) the reference to another device to initiate a print by references of the print content, wherein the another device (PR) comprises a print server (300) adapted to use the reference to obtain the print content.

With respect to claim 22, Kemp teaches wherein the reference specifies a print device (PR) to which the print service 300 is adapted to transmit the print content data in www Server DS.

With respect to claim 23, Kemp teaches receiving the print content from the print server 300. Output to anyone of printers PR previously selected based on capabilities as determined by the user.

With respect to claim 24, Kemp teaches passing the print content to a print device for printing. This is performed by print service 300.

With respect to claim 30, Kemp teaches a print reference method executable by a portable wireless device, the method comprising the steps of:

Obtaining a reference (www server DS) to print content stored at a location indicated by the reference; and wirelessly communicating (see figures 1 and 2) the

Art Unit: 2626

reference to another device to initiate a print by references of the print content, wherein the reference further specifies a print format (HTML to text by conversion terminal CS) format data specifying that the print content should be printed on new sheet of paper. This limitation is inherent since print content can be printed on whatever type of paper is desired by the user that the printer can utilize.

5.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp.

With respect to claim 32, Kemp teaches obtaining a reference (www server DS) to print content stored at an Internet location (URL) indicated by the reference; including the reference in a communication signal formatted according to a communication protocol such as HTML ; and wirelessly communicating (see figures 1 and 2), the communication signal to a print device 300 thereby causing the print device to use the reference to retrieve the print content from the URL (Internet) and to print the content to printer PR.

Kemp teaches all of the subject matter upon which this claim depends except for the specific limitation of Bluetooth communication protocols.

While other protocols are taught by Kemp, the use of Bluetooth is not specifically taught by applicant neither is a motivation provided as to why Bluetooth would be preferred as opposed to other methods. Hence, the user of Bluetooth or other equivalent protocols would have been recognized by one of ordinary skill in the art for the purpose of using a reference information obtained from the Internet for the purpose of printing its content.

With respect to claim 33, Kemp teaches a print reference method executable by a portable wireless device, the method comprising the steps of :


Obtaining a reference to print content stored at an Internet location indicated by the reference; including a reference in a communication signal formatted according to a protocol, such as HTML; and wirelessly communicating (see figures 1 and 2) to a print service (300) thereby causing the print service 300 to use the reference to retrieve the print content from the Internet, to format (via HTML to text via converter CS) the printing content and to pass the print content to the printing device PR.

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 571-272-7463. The examiner can normally be reached on Mon.-Thurs from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore , can be reached on 571-272-7463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II 
JEROME GRANT II
PRIMARY EXAMINER